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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,808	09/25/2003	Sandra Bauer	512425-2095	7580

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EXAMINER	
NILAND, PATRICK DENNIS	
ART UNIT	PAPER NUMBER

1714

DATE MAILED: 03/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/670,808

Applicant(s)

BAUER ET AL.

Examiner

Patrick D. Niland

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/03</u> . | 6) <input type="checkbox"/> Other: ____  |

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1. Claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the substituents disclosed in the enabling specification, does not reasonably provide enablement for all of the substituents encompassed by the instantly claimed recitations of "substituted". The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

A It would require undue experimentation to determine all of the members of the infinite group of substituents encompassed by the instant claims which would function in the instantly claimed invention, other than those disclosed in the enabling specification. For an infinite number of reasons, it is not expected that all of the encompassed substituents would function properly, e.g. they might be of too high of viscosity to be useful or might otherwise adversely affect the ability to regulate viscosity as necessary.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-10 are rejected under 35 U.S.C. 102(e) as being anticipated by US Pat. No. 6861493 Bauer et al..

A certified English translation of the applicant's priority documents is expected to remove this reference from being prior art.

Bauer discloses polyurethanes made with the instantly claimed polyethers. See the abstract. The urethane moieties of the patentee are encompassed by the instantly claimed recitations of "substituted" regarding the instantly claimed terminal R groups of the instantly claimed polyethers. See column 2, lines 63-67; column 3, lines 1-57; column 4, lines 1-67, particularly 21-45. As is understood, polymer molecules are a statistical mixture of molecules as evidenced by concepts such as average molecular weight and average functionality in polymer chemistry. These molecules can be broken into ratios giving the amount of the instant claim 6 with no affect on the patentee's composition. The mixture of molecules encompasses the polyurethane, water, and viscosity regulator of the instant claims 1-9. Claim 10 does not require nor exclude additional polyurethane. Thus, the method of use of the patentee encompasses that of the instant claim 10. It is used in inks and paints (column 1, lines 25-30).

5. Claim 10 is rejected under 35 U.S.C. 102(e) as being anticipated by US Pat. No. 6552091 Boinowitz et al..

Boinowitz discloses the method of the instant claim 10 at the abstract; column 2, lines 40-62 and the remainder of the document. Since the polyether of the patentee is the same as that of the instant claims, it will necessarily give the instantly claimed thickening in the composition of the patentee in which it is used.

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6. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 6552091 Boinowitz et al. in view of US Pat. No. 4155892 Emmons et al..

Boinowitz discloses the method of the instant claim 10 at the abstract; column 2, lines 40-62 and the remainder of the document. Since the polyether of the patentee is the same as that of the instant claims, it will necessarily give the instantly claimed thickening in the composition of the patentee in which it is used. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the polyether of Boinowitz in combination with polyurethane associative thickeners because Boinowitz states that they may be used with other conventional pigment wetting additives and resins at column 4, lines 40-42 and the thickeners of Emmons will necessarily wet hydrophilic pigments as do the hydrophilic polyethers of Boinowitz by definition of the well known concept of HLB (hydrophile/lipophile balance). Furthermore, the thickening of Emmons will prevent settling of the pigments due to the increased difficulties in pigments passing through more viscous media, which is well known to all in the art. The benefits of thickeners, as taught by Emmons, will be given to the final composition discussed above also.


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Patrick D. Niland  
Primary Examiner  
Art Unit 1714